

### **Remarks**

Claims 1, 2 and 4-20 are pending in this application. Claims 1, 2 and 4-7 stand rejected under 102(e) by Berg et al. (U.S. Patent Publication No. 2002/0188481; hereafter "Berg"). Claim 3 has been canceled. Claims 1, 2 and 5-7 have been amended. New claims 8-20 have been added. Support for the amendments may be found on page 4 lines 16-20, page 5 lines 5-10, page 11 lines 8-11, page 12 lines 4-7 and page 14 lines 4-7. The prior art rejections are addressed below.

### **Rejections under 35 U.S.C. 102**

Claims 1-7 were rejected under 35 USC 102(e) as being anticipated by Berg. These rejections are respectfully traversed.

Berg is generally directed toward a method for insurance claims processing, and more particularly, providing insurance coverage for online transactions. Specifically, Berg generates and provides a financial product which can provide insurance coverage "guaranteeing" the identity or financial viability of a user (or trading counterpart) and/or the completion of a transaction with a trading counterpart [0002]. The insurance coverage provides, in exchange for payment of a premium, assurance against the event that a user *has been misidentified* [0012], [0033]. Thus, rather than authenticating or positively identifying a User, Berg provides an online insurance product that provides *compensation* for when a user has been misidentified.

The system of Berg discloses various "entities" including: users (20) (e.g., marketplaces, buyers, sellers); a JV Authority (30); a Registration Authority (40); a Credential Issuing Authority (50); etc. (see, Figure 1). In operation, users (20) initially submit identifying information to a Joint Venture (JV) Authority (30). The JV Authority (30) processes the identifying information with information contained in a database of business information providers for verification [0007], [0063]. The JV authority (30) may be a business information provider such as Dun & Bradstreet, or may itself be a business information provider. The business information provider may provide information such as: contact information, financial risk assessment, financial viability, credit-worthiness, credit score, profitability, etc. [0005], [0006]. After verification is complete, the JV Authority (30) sends information regarding the user (20) to a

Registration Authority (40) that can register the verified user (20) and request security credentials from a Credential Issuing Authority (50) [0007], [0017].

Regarding claim 1:

Berg does not teach **wherein the User does not require use of software received from the Central-Entity to employ digital identity that includes a dynamic, non-predictable and time dependent SecureCode** as set forth in claim 1. Instead, Berg discloses a security credential, or unique identifier, that may take the form of: a user name, password, digital certificate, or alphanumeric identifier [0037]. However, the user name, password or alphanumeric identifier issued by Berg do not include a SecureCode that is dynamic, non-predictable and time dependent. Furthermore, the digital certificates of Berg do not meet the claimed limitation wherein the User does not require use of software received from the Central-Entity to employ digital identity. This is because digital certificates comprise files that are downloaded and/or installed on a user's computer. In paragraphs [0007] and [0011], Berg even states that the digital certificates may be *"downloaded and temporarily stored on any computer being used by a user" to verify identity and to facilitate subsequent interaction with trading counterparts* (emphasis added).

Berg also does not disclose that the **seller forwards digital identity received from the User to the Central-Entity**. The applicants' have been unable to find this feature in the paragraphs cited in the Office Actions. The applicants' requested that the Office specifically show where these features are necessarily present in Berg in the response filed (09/19/2006), however to date, no such evidence has been provided. Instead, in the Advisory Action paper number 20061010, the Office asserts that:

"Berg discloses that the JV Authority (i.e., Central-Entity) can process information (i.e., verifying identity) submitted by a user (i.e., External-Entity or a seller) in conjunction with information provided by a business information provider (i.e., another trusted entity) to verify the identity and/or financial viability of a trading counterpart or user (i.e., a buyer or requester). *This implies that the seller has received the buyer identity from the buyer before submitting to the JV Authority.* Thus, the disclosures of Berg system meet the limitations of the instant independent claims."

The applicants' respectfully disagree. For one, the business information provider is not the same as the seller. In other words, the buyer is not performing e-commerce with the business information provider. Furthermore, nowhere does Berg explicitly teach or even imply that the seller (i.e., the External-Entity) offering goods or services receives the security credentials or unique identifier

from the buyer and then submits it to the JV Authority. Rather, the buyer provides his unique identifier *to the "Central-Entity," or JV Authority*. "a user ... can access the instant invention by providing such credentials 10 or identifier *to the joint venture authority database*." See paragraph [0064]. Even more, Berg clearly illustrates the unique identifier being provided *to the JV Authority* (or JV Authority database) by means of the dotted line shown in Figure 1 (see [0064]). In Figure 2, Berg again distinctly shows the buyers and sellers each submitting their security credentials *to the JV Authority* by dotted lines 7 and 8. See [0066]. Thus, nowhere does Berg teach or even suggest the buyer providing his security credentials (as indicated by a dotted line) to the seller. Again, in Figure 3, previously verified users provide their unique identifiers *to the joint venture authority* (JV) 140. See [0067].

Furthermore, applicants' submit the Office's statement that it is *implied* that the seller has received the buyer identity from the buyer before submitting it to the JV authority is not a *prima facie* 102(e) rejection. A rejection based upon inherent or implied disclosure is improper and unsupportable absent any basis in fact and/or technical reasoning to reasonably support the determination that the "inherent" characteristic necessarily flows from the teachings of the applied prior art. *Ex parte Levy*, 17 USPQ 2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). See MPEP § 2112.

Regarding claim 2:

Berg does not disclose a digital identity that includes a **SecureCode and other user-specific information**. Instead, Berg discloses that the unique identifier or security credential may take the form of: a user name, password, digital certificate, or alphanumeric identifier [0037].

Regarding claim 5:

Berg does not teach a **dynamic, non-predictable and time dependable SecureCode** as set forth in claim 5. Berg discloses a security credential, or unique identifier, may take the form of: a user name; password; digital certificate; or alphanumeric identifier [0037]. However, the user name, password or alphanumeric identifier issued by Berg do not include a SecureCode that is dynamic, non-predictable and time dependent. Furthermore, the digital certificates of Berg do not meet the

claimed limitation wherein the User does not require use of software received from the Central-Entity to employ digital identity. This is because digital certificates comprise files that are downloaded and/or installed on a user's computer. In paragraphs [0007] and [0011], Berg even states that the digital certificates may be "*downloaded and temporarily stored* on any computer being used by a user" to verify identity and *to facilitate subsequent interaction with trading counterparts* (emphasis added).

Additionally, Berg fails to disclose method steps where: **"The External-Entity requests the user to authenticate himself using his digital identity," "The user submits his SecureCode as part of the digital identity in response to External Entity's request," and "The External-Entity forwards the user's digital identity ... to the Central-Entity"** (emphasis added). Nowhere in the disclosure of Berg can applicants' find the method steps where the seller actively **"requests"** the buyer to authenticate himself; where the buyer actively **"submits"** his SecureCode as part of the digital identity **"in response to"** the seller's request; and where the seller actively **"forwards"** the digital identity to the JV Authority. This is not surprising because all communication between the buyer and seller takes place via the intermediate marketplace (see e.g., figures 1-3). The applicants' have been unable to find this feature in the paragraphs cited in the Office Actions. The applicants' requested that the Office specifically show where these features are necessarily present in Berg in the response filed (09/19/2006), however to date, no such evidence has been provided. Instead, in the Advisory Action paper number 20061010, the Office asserts that:

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*the joint venture authority* database.” See paragraph [0064]. Even more, Berg clearly illustrates the unique identifier being provided *to the JV Authority* (or JV Authority database) by means of the dotted line shown in Figure 1 (see [0064]). In Figure 2, Berg again distinctly shows the buyers and sellers each submitting their security credentials *to the JV Authority* by dotted lines 7 and 8. See [0066]. Thus, nowhere does Berg teach or even suggest the buyer providing his security credentials (as indicated by a dotted line) to the seller. Again, in Figure 3, previously verified users provide their unique identifiers *to the joint venture authority* (JV) 140. See [0067].

Furthermore, applicants’ submit the Office’s statement that it is *implied* that the seller has received the buyer identity from the buyer before submitting it to the JV authority is not a *prima facie* 102(e) rejection. A rejection based upon inherent or implied disclosure is improper and unsupportable absent any basis in fact and/or technical reasoning to reasonably support the determination that the “inherent” characteristic necessarily flows from the teachings of the applied prior art. *Ex parte Levy*, 17 USPQ 2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). See MPEP § 2112.

Thus unlike the passwords, user names, and alphanumeric identifiers disclosed by Berg, the present invention provides digital identity-based authentication where the digital identity includes a SecureCode that is dynamic, non-predictable and time dependent. Further, unlike digital certificates which are stored on a user’s computer, digital identity does not require the use of software received from a Central-Entity. For example, the digital identity is calculated based on the SecureCode and user-specific information.

To anticipate a claim, **a reference must teach each and every element of the claim**: “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). See MPEP 2131. Applicants’ maintain that Berg fails to anticipate each and every element of the claims as is the statutory threshold for a *prima facie* rejection under 35 U.S.C. § 102(e). Accordingly, applicants’ submit that claims 1 and 5, and their dependents, as well as new claims 8-20 are allowable over the prior art of record.

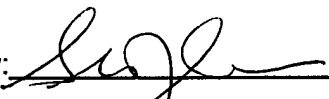
### **Conclusion**

The applicants' respectfully request reconsideration of the claim rejections based on the above amendments and remarks. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance. If the examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (571) 228-2938.

In response to the previous Office Action, the applicants' have further submitted a 2-month extension of time fee as required by § 1.17(a).

Respectfully submitted,

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